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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,704	02/06/2004	Joseph L. Ungari	005127.00266	7368
22910	7590	12/01/2005	EXAMINER	
BANNER & WITCOFF, LTD. 28 STATE STREET 28th FLOOR BOSTON, MA 02109-9601			STASHICK, ANTHONY D	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/774,704	UNGARI, JOSEPH L.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Anthony Stashick	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is **FINAL**.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-35 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 06 February 2004 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date: _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>03262004</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION*****Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in—

- (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
- (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 1-3, 5-6, 8-10, 13-16 and 27-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Parihar et al. 2004/0002665. Parihar et al. '665 discloses all the limitations of the claims including the following (see Figure 5): a sole structure 514; an upper 500 (noted as shoe but shown in Figure 5 to be pointing to the upper of the shoe) secured to the sole structure; at least one reservoir of magneto-rheological fluid in at least one of the upper and the sole structure 504; and a magnet assembly 510 proximate each reservoir; wherein a magnetic field produced by the magnet assembly transforms the magneto- rheological fluid from a fluid state to a near-solid state (see paragraphs [0116-0118]); the magnet assembly comprises a plurality of permanent magnets 510; when the article of footwear is in a first condition the permanent magnets are spaced apart from the reservoir (uncompressed state, i.e. when the user's foot is not in the shoe) and the magneto-rheological fluid is in a fluid state, and when the article of footwear is in a second condition (with user's foot in shoe) the permanent magnets are proximate the reservoir and create a magnetic field within the reservoir and transforms the magneto- rheological fluid into a near-solid state; the magnet assembly comprises a plurality of electromagnets 510; a load cell 518 configured to activate the electromagnets upon detection of a force from a user's foot; the load cell is positioned in the sole structure (see Figure 5); a power source 512 connected to the electromagnets; the

power source comprises a battery 512; the magnet assembly comprises a plurality of magnets 510 on a first side of a reservoir and a plurality of magnets 510 on an opposed second side of the reservoir (see Figure 5); the magneto-rheological fluid comprises magnetic particles suspended in oil (see paragraph [0011]); the magneto-rheological fluid comprises iron molecules suspended in silicon (MR fluids known to be contain silicon or oil); the reservoir of magneto-rheological fluid is located in a compressible support element 504 secured to a bottom surface (bottom of insole) of the sole structure.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 7, 11, 12, 17-19, 21-26, 29-31 and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parihar et al. 2004/0002665 as applied above in view of Sasaki et al. 5,230,249. Parihar et al. '665 as applied above discloses all the limitations substantially as claimed except for the reservoir of magneto-rheological fluid being located in the sidewall of the upper, the load cell positioned in the sidewall of the upper and a reservoir located in both the medial and lateral sidewalls of the upper. Sasaki et al. '249 teaches that for support to be given the user's foot to prevent rolling of the user's foot within the shoe, the upper of the shoe can have reservoirs 5C located on each side of the upper to give support to the user's foot during use. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention

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was made, to place reservoirs of MR fluids in the upper of the user's shoe to aid in giving varying support to the user's foot during use depending upon the support desired.

4. Claims 4, 20 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 3, 19 and 31 above, in view of Demon 5,813,142. The references as applied to claims 3, 19 and 31 above disclose all the limitations of the claims except for the article of footwear transforming from one state to another upon detection of a force from a user's foot. Demon '142 teaches that the support of a shoe can be adjusted based upon the force felt upon the shoe by the user's foot during use, by using sensors to send signals to an internal computer to adjust the rigidity of the supports. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place sensors in the support of the references as applied to claims 3, 19 and 31 above, to detect when more support was needed to activate the magnets to give more support to the user's foot during use.

### *Conclusion*

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and are cited on form 892 enclosed herewith.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday-Thursday 8:30 am to 4:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony Stashick  
Primary Examiner  
Art Unit 3728

ADS